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REMARKS

Claims 1-40 were pending. Claims 1-40 were rejected. Claims 41 and 42 had been previously cancelled. By virtue of this response, claims 1-40 have been cancelled, no claims have been amended, and new claims 43-89 have been added. Accordingly, claims 43-89 are currently under consideration.

Claim Rejections Under 35 USC §101

Claims 8-40 were rejected under 35 U.S.C. 101 for being allegedly directed to non-statutory subject matter.

Claims 8-40 are cancelled. However, Applicants respectfully traverse this rejection which was based on a finding that the claims do not recite "tangible embodiments of the invention." Applicants submit that this is not a recognized test for whether patentable subject matter exists under 35 U.S.C. 101. Rather, any invention that yields a "useful, concrete, and tangible result" may be patentable, subject of course to requirements outlined in 35 U.S.C 102 and 35 U.S.C 103. *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1373, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998). In cancelled claim 8, for example, counts were accumulated by subject and outputted. As such, cancelled claim 8 provided a useful, concrete and tangible result in that it outputted counts as recited in the claim limitations. Therefore, Applicants submit that the Examiner is apparently grafting a "technical arts" requirement onto 35 U.S.C. 101.

In the recent and precedential opinion *Ex Parte Lundgren* 76 USPQ2d (BNA) 1285 (BPAI September 28, 2005), the Board of Patent Appeals and Interferences (BPAI) held that "there is no currently judicially recognized separate technological arts test to determine patent eligible subject matter under §101." Therefore, at least because of this recent precedent established by the BPAI clarifying that the "technological arts" test is not recognized, Applicants submit that rejection of any method claims pending in this application based on 35 U.S.C. 101 is inappropriate

Claim Rejections Under 35 USC §103

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Claims 1-7 and 40 were rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Golding et al. (6,640,218) in view Liu et al. (6,839,680).

Claims 1-7 and 40 are cancelled.

New claims 43-67 have been added and are directed to various inventive aspects that Applicants submit are not taught or suggested by the Examiner's proposed combinations of Golding, Liu, Lesham, and Martin. These claims are different enough from previous claims that the Examiner's reasoning relating to previous claims is not pertinent to new claims 43-67. However, Applicants maintain that the concepts claimed in now cancelled claims were allowable over the proposed combinations of prior art references, and reserve the right to pursue such claims in related applications.

New claim 43 recites in part, "canonicalization logic for canonicalizing each of the events into a canonical term; categorization logic for aiding in categorization of each canonical term into at least one category; term counting logic for incrementing a count associated with each canonical term for each event associated with that canonical term; and normalizing logic operable to form statistics relating to aggregate interests of the plurality of users in each canonical term over the period of time."

Applicants urge the Examiner to consider previous positions concerning the "popularity lists" of Golding. These "popularity lists" are lists of web sites which were popular to other web users who entered the same search query as a presently searching user. See Col. 7, Lines 54-56, "[t]he popularity list includes popular items that have been previously selected by users in response to the same normalized query in the past." Applicants respectfully submit that Golding's disclosure relating to "popularity lists" is not pertinent to new claims 43-64. For example, Golding's popularity lists are not, "statistics relating to aggregate interests of the plurality of users in each canonical term over the period of time" as recited in claim 43. Applicants submit that new claim 43 is allowable over the proposed combinations of prior art references.

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Support for new claims 43-67 may be found throughout the specification, and particularly various figures illustrating statistical output and arrangement thereof as well as description relating to those figures (see for example FIGS. 9-14). In the context of the remainder of the specification, these figures provide further support for these new claims.

New method claims 68-86 have been added. Independent claim 68 recites, "canonicalizing events occurring on at least one server into canonical terms; incrementing a count associated with each canonical term for each event canonicalized into that canonical term; associating each canonical term with at least one category; normalizing counts associated with canonical terms to emphasize time dependent variation in aggregate user interest in those canonical terms; and outputting the normalized counts formatted to illustrate the time dependent variation in aggregate user interest." Applicants submit that Golding uses the term "normalizing" to refer to a different concept than normalizing in the context of the present claims. Golding "normalizes" queries by removing excess white space and the like. These sections of Golding do not teach normalize counts to "emphasize time dependent variation." See Col. 6, Lines 57-60 for information relating to Golding's use of "normalize." Therefore, the proposed prior art combinations do not teach or suggest each and every limitation of new claim 65. Likewise, claim 84 recites "normalizing counts associated with canonical search terms to obtain indicia of change in aggregate user interest in the canonical search terms."

Method claims 68-86 are directed to various aspects supported throughout the specification, in particular FIGS. 9-14 and description related thereto, as well as in cancelled claims. Applicants submit that no new matter was added by virtue of addition of these claims. Claim 81 is a method claim directed to another inventive aspect described at least at pages 11-13 of the specification. Claims 82-83 are directed to aspects of aggregate user interest illustrated in FIGS. 9-14, and in related description.

New claim 87 is directed to an apparatus for identifying affinity between search terms. Applicants submit that no combination of reference teaches or suggests all the limitations of new claim 87.

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Claims 88 and 89 provide further details relating to the apparatus of claim 87, and Applicants submit that claims 89 and 90 are patentable based on dependence from claim 88 as well as by virtue of these additional limitations.

Claims 8-39 were rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Golding et al. (6,640,218) in view of Leshem et al. (6,470,383), and further in view of Liu et al. (6,839,680).

Claims 8-39 are cancelled.

Claims 34, 35, 36, and 39 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Golding et al. (6,640,218) in view of Martin et al. (6,338,066), and further in view of Liu et al. (6,839,680).

Claims 34, 35, 36, and 39 are cancelled.

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CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 324212008100. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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